

## REMARKS

This amendment is in response to the May 29, 2002, office action.

Applicant has cancelled claims 1 to 31, therefore the Examiner's rejections of claims 1 to 31 under 35 USC 112, first and second paragraph, have been rendered moot.

New claims 32 to 48 are submitted for the Examiner's consideration. No new matter has been added.

Basis for new claim 32 appears on page 13, lines 20 to 28, and page 16, lines 20 to 23, of the specification.

Basis for new claim 33 appears on page 9, lines 6 to 7, page 14, lines 2 to 15, page 16, lines 26 to 28, and page 17, lines 4 to 6, of the specification, which refer to material placed within the intersection of the joint to form a curve along the joint to match the convexity of the cut corner of the fish resulting from the relaxing of the cut corner after removing the backbone of the fish. Although one would expect that the removal of the generally circular backbone of the fish results in a concave cut corner, the cut corner of the fish is unexpectedly convex along its length.

Basis for new claim 34 appears on page 13, lines 20 to 28, page 14, lines 1 to 15, page 15, lines 26 to 28, page 16, lines 7, 20 to 30, and page 17, lines 1 to 2, of the specification.

Basis for new claim 35 appears on page 9, lines 6 to 7, page 14, lines 2 to 15, page 16, lines 26 to 28, and page 17, lines 4 to 6, of the specification.

Basis for new claim 36 appears on page 8, lines 25 to 28, page 9, lines 24 to 25, page 14, lines 16 to 20, and page 17, lines 6 to 8, of the specification.

Basis for new claim 37 appears on page 9, lines 6 to 7, page 14, lines 2 to 15, page 16, lines 26 to 28, and page 17, lines 4 to 6, of the specification.

Basis for new claim 38 appears on page 8, lines 25 to 28, page 9, lines 24 to 25, and page 14, lines 16 to 20, of the specification.

Basis for new claim 39 appears on page 9, lines 6 to 7, page 14, lines 2 to 15, page 16, lines 26 to 28, and page 17, lines 4 to 6, of the specification.

Basis for new claim 40 appears on page 9, lines 24 to 25, and page 13, lines 19 to 28, of the specification.

Basis for new claim 41 appears on page 9, lines 6 to 7, page 14, lines 2 to 15, page 16, lines 26 to 28, and page 17, lines 4 to 6, of the specification.

Basis for new claim 42 appears on page 14, lines 13 to 15, and page 15, lines 14 to 16, of the specification.

Basis for new claim 43 appears on page 14, lines 2 to 13, and page 15, lines 3 to 9, of the specification, and Figure 4, which shows a curved V shaped groove 32 along the joint of the intersection.

Basis for new claim 44 appears on page 16, lines 8 to 20, of the specification.

Basis for new claim 45 is provided by cancelled claim 17.

Basis for new claim 46 is provided by cancelled claim 20.

Basis for new claims 47 and 48 is provided by cancelled claims 28 and 29, and appears on page 9, lines 6 to 7, page 13, lines 20 to 28, page 14, lines 2 to 15, page 16, lines 20 to 28, and page 17, lines 4 to 6, of the specification.

Claims 1 to 31 were rejected under 35 USC 103(a) as being unpatentable over Bass in view of Pierson et al, Comer, the Applicant's admission of the prior art, and Wetmore. Because new claims 32 to 48 have the same bases as cancelled claims 1 to 31, the Applicant shall respond

to the Examiner's rejections under 35 USC 103(a) as such rejections apply to new claims 32 to 48.

Bass discusses only a single central support body (page 3, line 3), and the figures of Bass show only one side of a cut of fish being supported. There is no suggestion in Bass to provide support for the corners formed between two or more cut surfaces of a fish, or any mention of the corners formed between one or more cut surfaces and the naturally contoured surface of the fish. Instead, the support and vacuum bag of Bass is directed towards overcoming perceived difficulties with respect to the structure and aesthetics of existing backing boards for cut fish (page 2, lines 7 to 24). Furthermore, the support of Bass is directed primarily for packaging smoked or marinated fish, not raw fish (page 1, lines 3 to 6, page 10, claim 17).

Bass also teaches that the cut fish placed on the support is conventionally directly vacuumed packed such that the vacuum bag presses the cut fish against the support without support for the cut corners of the cut fish (page 4, lines 17 to 18, figures 1 and 2). This feature is nearly identical to the process to wrap eviscerated fish against a flat base member disclosed in U.S. patent number 2,776,215 to Thomas identified by the Applicant on page 5, lines 25 to 30, and page 6, lines 1 to 7, of the specification of the claimed invention. The Applicant has discussed how such an invention would distort the curved meat surfaces by conforming them to the flat surface of a supporting member (page 9, lines 28 to 30, and page 10, lines 1 to 3). Therefore, Bass clearly teaches away from Applicant's claimed invention. Although Bass discloses an embodiment of the invention being a box having sidewalls (page 4, lines 9 to 11), it is clear from Figure 4 that these sidewalls do not provide support to any part of the fish.

Pierson et al teaches the use of an insert for packaging for bakery products which are arranged on either side of the insert (column 2, lines 12 to 13). The insert prevents the bakery

products from being crushed by their wrapping. However, the bakery products of Pierson et al are not vacuum packed because vacuum packing would crush the bakery products. Thus, Pierson et al cannot be combined with the vacuum packing of Bass to have the membrane compress the fish, because such compression would destroy the crush-preventing function of Pierson et al.

Furthermore, as can be seen from the drawings, the insert of Pierson et al does not conform to the cross-sectional shape of the bakery products. Bakery products are placed on both sides of the insert of Pierson et al in whole condition, and multiple products are placed within the same package (column 2, lines 12 to 13). There is no teaching or suggestion that the design of the insert is based on the cross-sectional shape of the bakery products.

However, even if Pierson et al can be interpreted to provide a support that roughly mimics the cross-sectional shape of the product, there is no teaching, suggestion or incentive to combine the aspects of a support backing board and vacuum bag (Bass) and an insert to prevent crushing during packaging (Pierson et al) to form the claimed invention.

Further, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of an applicant's invention, or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a) at 2100-91 to 92 (quoting In re Oetiker, 977 F.2d 1443, 1446 (Fed. Cir. 1992)). Pierson et al, a packaging for bakery products, is not even remotely analogous prior art because it is neither in the field of the Applicant's endeavor, nor is Pierson et al pertinent to the particular problem with which the Applicant is concerned, which is the support of cut surfaces and cut corners of cut fish; Pierson et al relates to packaging whole bakery products which, by definition, do not have any cut surfaces.

The Examiner asserts that Comer evidences that "it is well established to provide supports or inserts which are fashioned to assume the shape of the product to be packaged." The bone plastic cap for meat of Comer is directed towards meat with exposed bone portions (column 1, lines 13 to 19). There is no teaching, motivation, suggestion or incentive to combine the rigid support and vacuum bag of Bass with the bone plastic cap of Comer. Comer teaches that the bone plastic cap is intermediate between the meat product and an outer vacuum bag. In Bass, however, the vacuum bag directly contacts the cut fish. Therefore, the interposing of Comer's bone plastic cap between the fish and vacuum bag would destroy the direct contact function of Bass' vacuum bag.

Furthermore, like Pierson et al, Comer is not even remotely analogous prior art because it is neither in the field of the Applicant's endeavor, nor is Comer pertinent to the particular problem with which the Applicant is concerned. The claimed invention is directed to boneless cut fish, whereas Comer seeks to overcome the difficulties presented by exposed bone ends of cut meat. Furthermore, Comer teaches that the bone plastic cap collapses over and conforms to the meat product it packages (column 8, lines 3 to 45). Thus, Comer's bone plastic cap conforms to the meat product it packages, while in the claimed invention, the meat conforms to the supports to preserve the cut surfaces and cut corners of the meat.

The Examiner relies on Wetmore to show that triangular pie shaped cuts are conventional. However, there is no teaching, motivation, suggestion or incentive to combine Bass and Wetmore because Wetmore teaches the supporting of multiple cuts of fish using a single curved surface, which is the interior wall of a cylinder (column 1, lines 34 to 47), where the uncut contoured surfaces of the fish contact and support each other. This clearly teaches away from Bass, which discloses the support of only one cut of fish, where the entire cut of fish

is enclosed in a vacuum bag. Furthermore, Bass teaches that the food grade card attached to the support body has indica printed on the outwardly facing surface. Therefore, Wetmore cannot be combined with Bass because the curved support surface of Wetmore is the interior of a cylinder, and thus any indica printed on it cannot be viewed externally thus destroying the indica function of Bass. There is no teaching, motivation, suggestion or incentive to combine the fundamental feature of Wetmore – the single curved support surface, which itself seals in the fish – with the rigid support and separate vacuum bag of Bass. Indeed, the fundamental features of both inventions teach away from their combination.

Bass teaches the necessity of a separate sealing vacuum bag, while Wetmore teaches against a separate bag by using an enclosed curved surface. Wetmore teaches away from the claimed invention which uses multiple flat rigid supports. Furthermore, contrary to Examiner's assertion, the claimed invention is not only directed towards triangular pie shaped cuts of fish. While the Applicant discloses that a cross section of tuna loin is a substantially triangular pie shape (page 11, lines 19 to 20), Applicant expressly makes the claimed invention applicable not only to loins, but also to loins that have been further processed into sections or fillets that do not have a substantially triangular pie shape (page 12, lines 16 to 18, and page 18, lines 14 to 15).


The Examiner has not provided any evidence that Applicant's admission of the prior art teaching a cross-sectional cut product would have made the claimed invention "an obvious matter of design." On the contrary, Applicant's admission of the prior art teaches against the transport or shipping of a cross-sectional cut product due to the likely damage and deformation sustained by the cut corners and cut surfaces of fish. Furthermore, Applicant's limitation that curving material be provided to conform to any convexity along the cut corner of a cut fish

formed by the removal of the fish backbone is neither disclosed nor suggested by any reference in the prior art, whether singly or in combination.

There is, therefore, no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Bass with Pierson et al, Comer, Wetmore, or Applicant's disclosure of the prior art. The claimed invention teaches the use of supports to support of the cut surfaces and cut corners of cut fish, which is a use not contemplated by Bass, Pierson et al, Comer, Wetmore or any prior art cited by the Applicant. This rejection therefore constitutes impermissible hindsight reconstruction.

In view of the above, it is submitted that the claims are now in condition for allowance. Reconsideration and withdrawal of the rejections is requested. Allowance of the claims at an early date is earnestly solicited. If the claims would be in condition for allowance except for minor revisions, the Applicant's attorney courteously invites a telephone interview initiated by the Examiner so that such revisions can be effected by Examiner's Amendment.

Respectfully submitted,



Martin E. Hsia  
Registration No. 32,471  
CADES SCHUTTE FLEMING & WRIGHT  
P.O. BOX 939  
Honolulu, Hawaii 96808  
Telephone (808) 544-3835